

REMARKS

In the Office Action mailed April 24, 2003, Claims 1-21 are held subject to a restriction requirement, the Examiner contending that the claims are directed to more than one invention as follows:

- Group I – Claims 1-14 and 19-21, which the Examiner contends are directed to a polyurethane/geotextile composite; and
- Group II - Claims 15-18, which the Examiner contends are directed to a device for making an absorbent fibrous web.

Applicants herein affirm the election without traverse, made by the undersigned (not Ms. Sloane, as stated at page 2, paragraph numbered 4 of the instant Office Action) in a telephone conversation with the Examiner on February 12, 2003, to prosecute the claims of Group I (Claims 1-14 and 19-21), and therefore withdraw Claims 15-18. Applicants reserve the right to file divisional application(s) to the non-elected subject matter.

In that same Office Action mailed April 24, 2003, Claims 1-6, 8-10 and 19-21 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,421,677 issued to Adam et al. Claims 1-6, 8-10 and 21 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1 and further in view of U.S. Pat. No. 6,187,982 issued to Markusch et al. Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1 and further in view of

U.S. Pat. No. 4,853,054 issued to Turner et al. Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1. Claim 11 is rejected under 35 U.S.C. §112, second paragraph as being indefinite.

Rejections under 35 U.S.C. §112, second paragraph

Claim 11 is rejected under 35 U.S.C. §112, second paragraph as being indefinite.

Claim 11 has been amended to state that the low molecular weight diol or triol comprises 0 % by weight of the isocyanate reactive component b), i.e., that component b) does not include a low molecular weight diol or triol.

Applicants submit that because of the above-detailed change, the Claim 11 is in compliance with 35 U.S.C. §112, second paragraph, and respectfully request the Examiner reconsider and reverse her rejection of that claim under 35 U.S.C. §112, second paragraph, as being indefinite.

Rejections under 35 U.S.C. §102(b)

Claims 1-6, 8-10 and 19-21 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,421,677 issued to Adam et al. Claim 1 has been cancelled, thus obviating any grounds for rejection based upon that claim. Applicants respectfully disagree with the Examiner.

The geotextile of the instant claims is impregnated with an unfilled polyurethane composition. The instant specification, at page 4, lines 24-26, states

As used herein, the term "unfilled polyurethane composition" means a polyurethane produced from a reaction mixture which **does not include any filler materials**. (Emphasis added).

Adam et al. at col. 2, lines 33-35 state that,

The composition of the present invention **r** **quir** **s** a) one or more polyisocyanates, b) **on** **or** **mor** **fill** **rs**, c) a polyol mixture and d) a catalyst. (Emphasis added).

Applicants respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Adam et al. does so.

Therefore, Applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 2-6, 8-10 and 19-21 under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,421,677 issued to Adam et al.

Rejections under 35 U.S.C. §§102(b)/103(a) (Markusch et al. '917)

Claims 1-6, 8-10 and 21 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. Claim 1 has been cancelled, thus obviating any grounds for rejection based upon that claim. Applicants respectfully disagree with the Examiner.

Applicants again respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is

contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Markusch et al. '917 does so.

Markusch et al. '917 teaches, at col. 9, lines 15-20, that water may be used as a blowing agent in an amount of from 0.1 to 10 weight percent, whereas the instantly claimed invention limits the water to no more than 0.1 weight percent.

Markusch

et al. '917 also teaches the inclusion of fillers, at col. 8, lines 48-54, whereas the instantly claimed invention excludes fillers as was noted above. *still includes*

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Clearly there is no such teaching, suggestion or motivation shown in the reference in this case.

Therefore, Applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 2-6, 8-10 and 21 under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al.

Rejections under 35 U.S.C. §103(a) over Markusch et al. '917 in view of Markusch et al. '982

Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1 and further in

view of U.S. Pat. No. 6,187,982 issued to Markusch et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al. '917 further in view of Markusch et al. '982.

Applicants' comment with respect to Markusch et al. '917 given above are equally applicable to the instant rejection. Markusch et al. '917 does not teach or suggest the instantly claimed invention. As the Examiner has admitted at page 6, paragraph numbered 11, Markusch et al. '917 does not disclose using polyoxypropylene polyether. Further, Markusch et al. '982 fails to add the missing teaching or suggestion that would lead one of ordinary skill in the art to the instantly claimed invention.

Therefore, Applicants contend that nothing in the teaching of Markusch et al. '917 further in view of Markusch et al. '982 would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claim 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1 and further in view of U.S. Pat. No. 6,187,982 issued to Markusch et al.

Rejections under 35 U.S.C. §103(a) over Markusch et al. '917 in view of Turner et al.

Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1 and further in view of U.S. Pat. No. 4,853,054 issued to Turner et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al. '917 further in view of Turner et al.

Applicants' comment with respect to Markusch et al. '917 given above are equally applicable to the instant rejection. Markusch et al. '917 does not teach or suggest the instantly claimed invention. As the Examiner has admitted at page 6, paragraph numbered 12, Markusch et al. '917 fails to teach the amount of polyurethane composition applied to the substrate. Further, Turner et al. fails to add

the missing teaching or suggestion that would lead one of ordinary skill in the art to the instantly claimed invention.

Therefore, Applicants contend that nothing in the teaching of Markusch et al. '917 further in view of Turner et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1 and further in view of U.S. Pat. No. 4,853,054 issued to Turner et al.

Rejections under 35 U.S.C. §103(a) over Markusch et al. '917

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al. '917.

Applicants' comment with respect to Markusch et al. '917 given above are equally applicable to the instant rejection. Markusch et al. '917 does not teach or suggest the instantly claimed invention. As the Examiner has admitted at page 7, paragraph numbered 13, Markusch et al. '917 does not state the thickness of the polyurethane coated substrate.

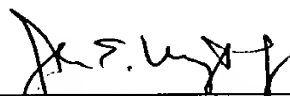
Therefore, Applicants contend that nothing in the teaching of Markusch et al. '917 would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claim 14 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al.

Conclusion

Applicants have cancelled Claims 1 and 15-18, have amended Claims 2-14 and 21 and have added Claims 22-32. Applicants further contend that such claim amendments add no new matter and find support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 2-14 and 19-32. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is requested to contact the Applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

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